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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,894	07/06/2001	Craig S. Caldwell	30906	3616

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,894

Applicant(s)

CALDWELL, CRAIG S

Examiner

Matthew O Savage

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 10-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Joseph et al '011.

With respect to claim 1, Joseph et al disclose a pan having a bottom surface 76 (see FIGS. 6-7), a filter media 70 spaced above the bottom surface and spanning the pan, an inlet 80 operable to initially direct the return fluid below the filter media, and an outlet 66 located above the filter media and operable to release the return fluid, the filter media being operable to filter fluid flowing from the inlet to the outlet.

As to claim 3, Joseph et al disclose a lid 62 positioned above the media.

Regarding claim 4, Joseph et al disclose the outlet 66 as comprising a slot in the lid.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al '011 in view of Pudlo.

With respect to claim 2, Joseph et al fail to specify spacers projecting upwardly from the bottom surface of the pan and operable to support the filter media above the bottom surface. Pudlo discloses the concept of providing spacers 23 projecting upwardly from the bottom surface of a pan 11 and operable to support the filter media above the bottom surface and suggests that such an arrangement prevents flexing of the media. It would have been obvious to have modified the filter of Joseph et al so as to have include spacers as suggested by Pudlo in order to prevent flexing of the filter media.

Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al '011 in view of Joseph '827.

With respect to claim 5, Joseph et al '011 discloses a return side filter for a transmission operable to filter the return fluid including a pan 76 having a bottom surface (see FIGS 6-7), a filter media 50 spaced above the bottom surface and substantially spanning the pan, a return side inlet 80 operable to initially direct the return fluid below the filter media, and an outlet 66 located above the filter media and operable to release the return fluid, the filter media being operable to filter fluid flowing from the return side inlet to the outlet. Joseph et al fail to specify a sump operable to receive fluid via a sump inlet. Joseph '827 discloses an analogous filter disposed in the sump of a transmission, the sump being operable to receive fluid via a sump inlet since it includes

fluid therein, the sump inlet being coupled to the return side inlet 36 (see FIG. 3), and suggests that such an arrangement is known in the art. It would have been obvious to have modified the filter of Joseph et al '011 so as to have included a sump having an inlet coupled to the return side inlet of a filter as suggested by Joseph '827 provide a filter for a transmission in a known way.

Concerning claim 7, Joseph '827 discloses return fluid 46 as being released into the sump since the sump includes fluid therein.

As to claim 8, Joseph et al disclose a lid 62 positioned above the media.

Regarding claim 9, Joseph et al disclose the outlet 66 as comprising a slot in the lid.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al '011 in view Joseph '827 as applied to claim 5 listed above, and further in view of Pudlo.

With respect to claim 6, Joseph et al fail to specify spacers projecting upwardly from the bottom surface of the pan and operable to support the filter media above the bottom surface. Pudlo discloses the concept of providing spacers 23 projecting upwardly from the bottom surface of a pan 11 and operable to support the filter media above the bottom surface and suggests that such an arrangement prevents flexing of the media. It would have been obvious to have modified the filter of Joseph et al so as to have include spacers as suggested by Pudlo in order to prevent flexing of the filter media.

Applicant's comments and amendments to claims 1 and 5 filed on 6-3-03 are sufficient to overcome the associated rejections under 35 U.S.C. 112, first and second paragraphs.

Applicant's amendments and arguments filed 6-3-02, with respect to the rejections of claims 1-9 under 35 U.S.C. 102(b) and 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, new ground(s) of rejection have been made in view of Joseph et al '011, Joseph '827, and Pudlo.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

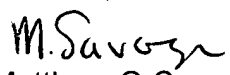
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Matthew O Savage
Primary Examiner
Art Unit 1723

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August 4, 2003